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Supreme Court of the United States

OCTOBER TERM, 1943.

No. 378.

THE GLEMBY CO. INC. and NEW YORK
MERCHANDISE CO. INC.,

Petitioners,

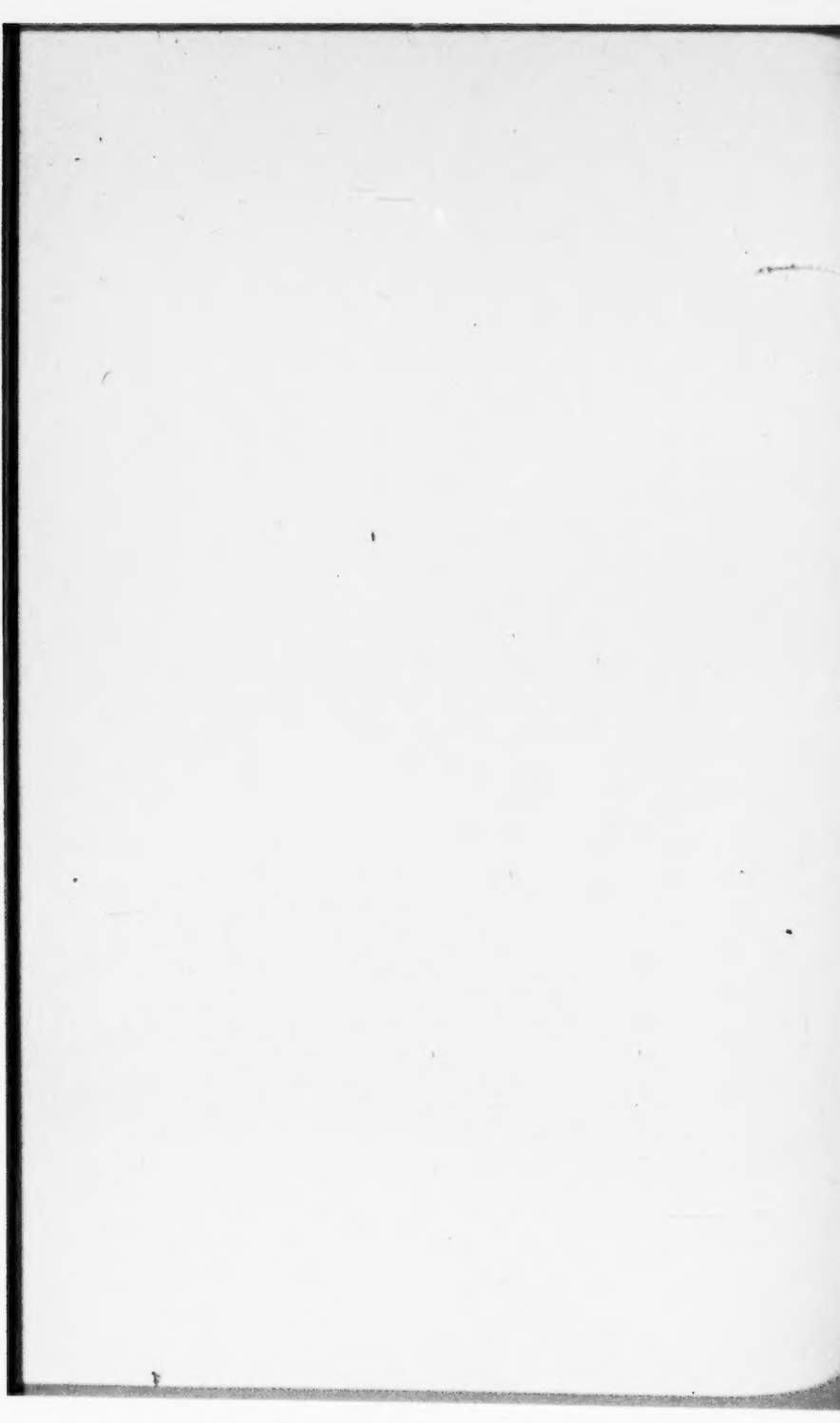
AGAINST

MONOGRAM MANUFACTURING CO.,

Respondent.

Respondent's Brief Opposing Petition for Writ
of Certiorari.

HENRY T. HORNIDGE,
Counsel for Respondent.



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*To the Honorable the Chief Justice and Associate Justices
of the Supreme Court of the United States:*

Respondent respectfully submits that the petition fails to state any ground for grant of Certiorari.

Concise Statement of Case.

Because the summary contained in the petition is somewhat inaccurate and misleading, it is desired to summarize the true facts as found below.

The Visitacion reissue patent (R. 198) teaches a simple, one-piece hair curler embodying novel means for automatically pinning the curl after it is formed and providing maximum simplicity of operation and economy of manufacture. The curler "had a real commercial success" (R. 253). Petitioner Glemby was exclusive licensee under the invention from a time prior to the filing of

the application for the original patent until after the original patent issued (R. 202) and, as such, required that the original application be prepared, filed and prosecuted by its, Glemby's, own patent attorney (R. 131).

In the most specific form of the invention a spring was mounted between the curling arms to more tightly grip the initial hair strand, but, as the evidence shows and, indeed, as is obvious, the spring was by no means essential to operation. In preparing and prosecuting the Visitacion application said attorney inadvertently limited most of the claims to the inclusion of the unnecessary spring, the error arising because of said attorney's faulty memory of the state of the art (R. 192-3), not because of an error in judgment. Visitacion promptly discovered the error upon issuance of the original patent and filed application for reissue to correct it within less than three months after the original issuance, and prosecuted the application to final issuance of the reissue patent within six months.

At page 7, the petition contains a misleading statement indicating that Visitacion signed the reissue application without reading it. The record shows (R. 152) that the complete application was read to him by his attorney before he signed it, since Visitacion was of Filipino birth and did not read English very well.

In the stipulated facts (R. 201), petitioners stipulated that the accused manufacture occurred "after June 13, 1939", which was the date of the reissue patent. The only allegation of intervening rights in the pleadings (R. 9) related to manufacture by *third parties*, which manufacture, petitioners contended, inured to the public at large. However, the trial court found that the intervening manufacture relied upon did not embody the invention and therefore could not constitute an intervening right in favor of anyone (R. 237-8).

POINT 1.

The question proposed here is whether or not a defendant may successfully assert personal intervening rights against a reissue patent by virtue of manufacture commenced *after* application for the reissue was filed but before the reissue patent issued.

This question does not exist in this case, however, because there is an absence of any allegation of personal intervening rights arising out of defendant's own manufacture, and the question posed ignores the stipulation of facts reciting specifically that petitioners' manufacture occurred only after the date of issuance of the Visitacion reissue patent (R. 201).

And, in addition to the absence of such an issue, there is the total absence of conflict in the decisions relating to the posed question.

Petitioners are manifestly wrong in attempting to support their contention of conflict by inferring that this Court, in the following cited cases, approved the awarding of intervening rights to a defendant who did not enter the field until after the patentee had applied for a reissue:

Topliff v. Topliff, 145 U. S. 156;

Keller v. Adams-Campbell Co., 264 U. S. 314;

Sontag Chain Stores, Ltd. v. National Nut Company of California, 310 U. S. 281

and in inferring that the District Court in *Moto Meter Gauge & Equipment Corp. v. E. A. Laboratories, Inc.*, 55 Fed. (2d) 936 (DC), approved any such doctrine.

No question of intervening rights was decided in either *Topliff v. Topliff* or *Keller v. Adams-Campbell*. In the latter case, this Court originally granted Certiorari to consider whether intervening rights accruing by virtue

of manufacture commenced *before the filing of the application for reissue* should terminate with the granting of the reissue. The Court, however, found that no such issue was present in the case and therefore dismissed the writ. At the bottom of page 11 of the petition, petitioners attempt to infer that this Court, in *Keller v. Adams-Campbell*, stated that the question here propounded was "an important issue of general patent law". The attempt has no basis in fact. It should be pointed out that the short quotation there made from *Keller v. Adams-Campbell*, was merely a fragmentary part of the following sentence:

"We therefore find ourselves mistaken in assuming that an important issue of general patent law under Sec. 4916, Rev. Stat. (Comp. Stat. Sec. 9461, 7 Fed. Stat. Anno. 2d ed. p. 211), is here involved."

Also, it should be pointed out that in discussing the *Keller v. Adams-Campbell* case at page 12 of the petition, petitioners have attempted to interpret *Topliff v. Topliff* on the basis of dictum appearing in the *Keller v. Adams-Campbell* case and, in that interpretation, attempt to give a significance to the words "pending the application and grant of the reissue", which obviously was not intended in *Keller v. Adams-Campbell*. It is clear from a study of those cases that when the Court made the quoted statement in *Keller v. Adams-Campbell*, it was referring to intervening rights established by manufacture at a time when the patentee was still waiting to file his application for reissue and which reissue could not be enforced until the application matured into a reissue patent.

The *Sontag Chain Stores, Ltd. v. National Nut Company of California* and *Moto Meter Gauge & Equipment Corp. v. E. A. Laboratories, Inc.*, cases dealt only with in-

tervening rights accruing before application for the reissue was filed.

The rule uniformly applied by the various Circuit Courts of Appeal is that while intervening rights may accrue if the party asserting them entered the field before the patentee filed application for reissue, they are not allowable to those entering the field after the filing of application for reissue. The wisdom of this doctrine in view of the express provisions of the statute (R. S. 4916) and its uniform application by the Courts, have rendered unnecessary any review by this Court.

In *Ashland Firebrick Co. v. General Refractories Co.*, 27 Fed. (2d) 744, 746, the Circuit Court of Appeals carefully reviewed this point, saying:

“In approving and adopting the theory of estoppel to support a private intervening right in the nature of a license as against a generally valid reissue, we do not overlook the difficulty which sometimes exists in finding all the elements of a conventional estoppel. If, within the two-year period and before the defendant, relying on the limitations in the original patent, has acted to his prejudice (*e. g.*, by building a noninfringing machine) the patentee had filed his application for reissue, manifestly the defendant could not claim any intervening right, although he acted upon the faith of the dedication in the original patent, being without knowledge of the reissue application. This consideration is not, we think, inconsistent with the finding of a true estoppel in a case where the reissue application had not been filed thus early. The right to claim the estoppel depends upon the dedication and its existence as a continuing offer of immunity. By his reissue application, the patentee withdraws that offer, in the only generally

possible way. When the defendant acts, he knows that the offer may have been withdrawn in this effective but nonpublic way, and he takes his chances upon the existence of such a withdrawal. Lacking any legislation, the loss must fall upon the later comer."

This Court denied Certiorari in that case (278 U. S. 662, 73 L. Ed. 569), but reasoning of the case was later approved in *Sontag Chain Stores, Ltd. v. National Nut Company of California, supra*.

Petitioners Are Estopped to Claim Intervening Rights.

As pointed out in the concise statement, the reissue was necessitated because of a mistake arising out of the inadvertent act of petitioner Glemby's own patent attorney. In legal contemplation, the mistake of petitioners' attorney is chargeable to petitioners and therefore they may not profit thereby by claiming intervening rights even if any had otherwise been established.

POINT 2.

The question proposed under this point is: Must intervening rights be based upon personal estoppel or can any member of the public rely upon intervening use by another member of the public?

This question cannot come before this Court in this case, however, because the trial court found that, as a matter of fact, no third party had made any device embodying the Visitacion invention and that, therefore, no intervening rights by third parties had been established (finding 17, R. 237). The Court of Appeals affirmed this finding, saying:

"But we need not consider this law here for no intervening rights have been established" (R. 257).

Consequently, there is no such question of law now in the case. *The petition does not challenge the finding of fact upon which the Court below based its conclusion that no intervening right by third parties had been established.*

POINT 3.

Under "Point 3" petitioners ask whether intervening rights can be established by one who *merely files* a patent application, showing what petitioners claim to be a replica of the accused device, prior to the filing of application for the original patent upon which the reissue was based.

No defense based upon the determination of this question was asserted in the pleadings, although petitioners did argue the question in the brief below and the Court there ruled that the mere filing of a patent application did not create intervening rights (R. 257).

The basis of petitioners' argument is so lacking in merit that only one instance can be found in the reported cases where such a defense was even urged. *American Automotoneer v. Porter*, 232 Fed. 456. In that case the ruling was negative. Contrary to petitioners' argument that the Court there relied upon the doctrine of personal knowledge of the original limited claims, a study of the case shows that the Court actually relied upon the fact that

"There is no evidence that the inventors under any one of them manufactured, and so they do not seem to have done anything in reliance upon the apparent dedication made in the first patent, excepting merely that they paid their final fees."

In the instant case, the Court below was reasonably convinced that Freeman, the party who filed the applica-

tion relied upon by petitioners, copied the subject matter from Visitacion's models:

"It appears that Freeman was employed by a Glemby director, frequently visited that company, and quite possibly saw Visitacion's models and consciously or unconsciously may have copied them" (R. 252).

This is a good indication of the possible abuses which could result if such a doctrine as urged by petitioners existed.

Indeed, it appears obvious that the only pertinency which the mere filing of an application for a patent by another could have, is to raise an issue of priority of invention. That issue was raised below and was there decided in favor of Visitacion after full consideration of the evidence.

POINT 4.

Here petitioners attempt to appeal from the holding below that the oath supporting the reissue was sufficient. The opinion of the Circuit Court of Appeals (R. 255-6) reviews the facts supporting its decision and that decision is in accord with the rule stated in *Topliff v. Topliff*, *supra*, and uniformly applied by the Courts:

"This Court will not review the decision of the Commissioner upon the question of inadvertence, accident, or mistake unless the matter is manifest from the record."

POINT 5.

The gist of petitioners' contention here is that the Visitacion reissue patent was not for the same invention

as was the original patent, and in this respect the petition is merely an attempt to appeal from the finding of fact below reading as follows:

“8. The Visitacion Reissue patent in suit No. 21,117 is for the same invention as was disclosed in the original Visitacion Patent No. 2,132,500” (R. 235), which finding was affirmed by the Court of Appeals (R. 255).

The record shows that the substance of the invention disclosed by the original patent (R. 199) was not changed by the reissue.

The decision below was, in no respect, contrary to the decision of the Court in *U. S. Industrial Chemicals v. Carbide & Carbon Chemicals Corp.*, 350 U. S. 668. The Court below (R. 253-5) fully distinguished the facts of this case from those of the *U. S. Industrial Chemicals v. Carbide & Carbon Chemicals Corp.*

POINT 6.

The purported question which petitioners attempt to propound under “Point 6” is too vaguely and incompletely expressed to be understood. Patent Office Rule 75 merely relates to a procedural step in Patent Office practice for antedating a reference patent “which substantially shows or describes but does not claim” the invention which it is cited to anticipate. It does not preclude a patentee from later establishing earlier dates.

The petition fails to name any such reference patent upon which any claim of the Visitacion application was rejected and, therefore, fails to show that there was any obligation imposed upon Visitacion to file any oath under Rule 75. Moreover, it may be stated as a matter of fact that no application of Rule 75 became pertinent during the prosecution of the Visitacion application, as will be

shown by an inspection of the Visitacion file histories (Exhibits 5 and K).

POINT 7.

"Point 7" is an attempted appeal from the following finding of fact by the trial court, affirmed by the Court of Appeals:

"Visitacion made the invention set forth in claims 11, 12, 13 and 15 of the Visitacion Reissue patent in suit No. 21,117, disclosed it to others, built and successfully operated working models thereof and fully reduced the same to practice prior to the filing date of Freeman Patent No. 2,278,541, dated April 7, 1942 (Defendants' Exhibit H)" (Finding 15, R. 237).

In summarizing the evidence upon which this finding was based, the trial court said in its opinion (R. 228):

"The corroborated testimony shows, however, that Visitacion was working on hair curlers as early as June, 1935, and had made three models, Exhibits 13, 14 and 15, had drawings prepared, and had submitted the models and drawings to a patent attorney before September 16, 1936, and had used the models in making curls on a living person as well as upon a wig. * * * The models and drawings clearly show that Visitacion conceived the invention and reduced it to practice before Freeman's application date."

And the Appellate Court said:

"In all this we have no doubt there was a reasonably sufficient reduction to practice to antedate

Freeman's invention, especially as it appears that Freeman was employed by a Glemby director, frequently visited that company and quite possibly saw Visitacion's models and consciously or unconsciously may have copied them" (R. 252).

The record amply supports the finding below that Visitacion's early completion of the invention was fully corroborated. But even if there had been only the testimony of Visitacion, the lack of other witnesses would not necessarily have been fatal under the authorities if his testimony, taken in conjunction with all the circumstances of the case, clearly indicated a completion of the invention.

For instance, this Court held, in *Corona Cord Tire Co. v. Dovan Chemical Corporation*, 276 U. S. 358, 382, that the testimony of only one witness, when considered in conjunction with other circumstances of the case, may be sufficient to establish reduction to practice, the Court there saying:

"The fact that he is the only witness is not fatal or any reason for denying its weight in connection with other circumstances."

There is no conflict in the authorities. In fact, every case depends upon a full consideration of its peculiar facts and surrounding circumstances. The proof required to establish completion of a model which is not produced in Court or which is of a very complicated nature obviously would be greater than that required to establish completion of a model which is before the Court and whose structure and capabilities are so obvious as to speak for themselves.

The cases cited at page 16 of the petition are neither in point nor in conflict with the decision below. Those

cases related to complicated inventions of which models allegedly had been made but which were not presented in Court, and there was no corroboration of the inventor's statement as to when he made the model and how it was constructed. The *Collins v. Olsen*, 102 Fed. (2d) 828, case cited concerned a process invention involving a number of steps and the testimony presented related to only one of the steps, so that it was incomplete.

CONCLUSION.

It is therefore respectfully submitted that the petition should be denied.

HENRY T. HORNIDGE,
Counsel for Respondent.

